

**REMARKS/ARGUMENTS**

Reconsideration of the application is respectfully requested for the following reasons:

**Rejection of Claims 1-17 Under 35 U.S.C. §112, first paragraph**

In response to this rejection, Applicants have amended claims 1 and 15. Reconsideration of claims 1-17 is respectfully requested. These amendments to claims 1 and 15 are based on the paragraph which begins on line 9 of page 5 and discloses " FIG. 2C shows the removing and preventing of the epitaxial silicon or silicon-containing residue 212 attached on the insulation surface. Herein, when removing, the etching process with DHF (Dilute HydroFluoric acid) is used. In the etching process of the embodiment, preferably about 10 Å of the insulation surface, on which may have the epitaxial silicon or silicon-containing residue 212, is removed. And in the meantime, less than 10 Å of the epitaxial silicon 211 surface on the semiconductor surface is removed. In other words, in the present invention, the removal rate of the epitaxial layer is slower than the removal rate of the insulation surface." Withdrawal of these rejections is respectfully requested.

**Rejection of Claims 1-10, 13-16 and 18 Under 35 U.S.C. §102(b)**

Claims 1-3, 5-13 are rejected under 35 U.S.C. §102(b) as being anticipated by Furukawa (US 6,228,728 B1). Applicants respectfully traverse this rejection. This rejection is traversed because Furukawa actually fails to teach every element of the claimed invention. As shown in FIGs. 1-8 and the related description of embodiment 1 of Furukawa, the silicon fragments 10a on the silicon nitride spacers 9 are not removed contrary to the claimed invention. Instead, the silicon fragments 10a together with the silicon substrate 1 and the epitaxial silicon layers 10 are oxidized in an oxygen atmosphere of 600 to 900 degrees C. for forming silicon oxide films 11 on the surface thereof to avoid an electrical conducting state caused by the silicon fragments 10a. As shown in FIG. 5, a metal thin film 22 is formed on the silicon substrate 1 and the silicon fragments 10a with the silicon oxide films 11 on the surface thereof remain. The Examiner states that the silicon fragments 10a are selectively removed by wet etching in a mixed solution of hydrofluoric acid and nitric acid. According to the teaching of embodiment 6 of Furukawa, the higher removal rate of the silicon fragments 10a than that of the epitaxial silicon layers 10 results from the larger surface areas exposed to the mixed solution of the silicon

fragments 10a as well as the smaller mean thickness of the silicon fragments 10a comparing to those of the epitaxial silicon layers 10. Furukawa fails to show the different removal rates of the silicon fragments 10a and any insulation layer resulting in the removal of the silicon fragments 10a. According to MPEP §2131, To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. It is quite clear that the teaching of Furukawa actually fails to teach every element of the claimed invention and one with ordinary skill in the art would not anticipate the claimed invention by the teaching of Furukawa.

Rejection of Claims 4, 14 and 15-17 Under 35 U.S.C. §103(a)

Claims 4 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Furukawa et al. and further in view of Shishiguchi (US 6,190,976 B1).

Applicants respectfully traverse this rejection since Shishiguchi does not teach the element which Furukawa fails to disclose. The combination of Furukawa and Shishiguchi is still insufficient to render the claimed invention unpatentable. According to MPEP §2143, Basic Requirements of a Prima Facie Case of Obviousness[R-1], To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Since the combination of Furukawa and Shishiguchi does not teach all the limitations of the claimed invention, the combination of Furukawa and Shishiguchi is insufficient to render the claimed invention unpatentable.

Claims 15 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Furukawa et al. further in view of Shishiguchi.



Applicants respectfully traverse this rejection. This rejection is traversed because the combination of Furukawa and Shishiguchi actually fails to teach every element of the claimed invention. Furukawa only shows that the higher removal rate of the silicon fragments 10a than that of the epitaxial silicon layers 10 results from the larger surface areas exposed to the mixed solution of the silicon fragments 10a as well as the smaller mean thickness of the silicon fragments 10a comparing to those of the epitaxial silicon layers 10. Furukawa fails to show the different removal rates of the silicon fragments 10a and any insulation layer resulting in the removal of the silicon fragments 10a. Shishiguchi does not teach the element which Furukawa fails to disclose either. Since the combination of Furukawa and Shishiguchi does not teach all the limitations of the claimed invention, the combination of Furukawa and Shishiguchi is insufficient to render the claimed invention unpatentable according to MPEP §2143.

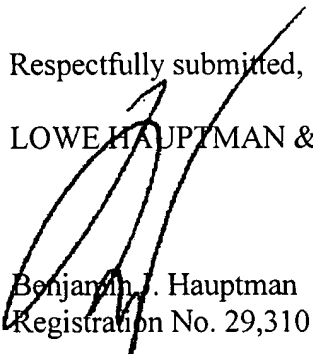
#### **Conclusion**

In light of the above remarks to the claims, Applicant contends that Claims 1-17 are patentable thereover. The claims are in condition for favorable consideration and Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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